

IN THE UNITED STATES DISTRICT COURT  
FOR THE MIDDLE DISTRICT OF TENNESSEE  
IN NASHVILLE

TENNESSEE WALKING HORSE	)	
BREEDERS' AND EXHIBITORS'	)	
ASSOCIATION,	)	
	)	No. 1:05-0088
Plaintiff,	)	
	)	
v.	)	Judge Campbell
	)	
NATIONAL WALKING HORSE	)	Magistrate Judge Knowles
ASSOCIATION,	)	
	)	
Defendant.	)	

**DEFENDANT'S RESPONSE TO  
PLAINTIFF'S STATEMENT OF UNDISPUTED MATERIAL FACTS IN SUPPORT OF  
ITS MOTION FOR PARTIAL SUMMARY JUDGMENT**

Defendant, National Walking Horse Association (Defendant or "NWhA") submits its Responses to the Statement of Undisputed Material Facts filed by Plaintiff, Tennessee Walking Horse Breeders' and Exhibitors' Association (Plaintiff or "TWHBEA"), which is reproduced below without Plaintiff's footnotes.

1. In 1935, Plaintiff created and established a registry to record the pedigrees of Tennessee Walking Horses ("the TWHBEA Registry").

**RESPONSE:** Undisputed for purposes of summary judgment only.

2. The TWHBEA Registry contains over 70 years' worth of unbroken ancestral lineage records for Tennessee Walking Horses. TWHBEA maintains in its possession the pedigree of every horse registered with us since 1935, and keeps these in two fireproof vaults.

Every single horse that is registered with TWHBEA has its Registration Certificate on file with TWHBEA, showing an unbroken chain since TWHBEA's founding in 1935.

**RESPONSE:** Undisputed for purposes of summary judgment only.

3. As of November 13, 2006, TWHBEA had approximately 430,000 horses in its Registry, giving it a market share of 98% of registered Tennessee Walking Horses.

**RESPONSE:** Undisputed for purposes of summary judgment only.

4. TWHBEA issues ownership and pedigree certificates based on a horse's satisfaction of the selection criteria, including establishment that the horse is a pure-bred Tennessee Walking Horse ("TWHBEA Registry Certificates").

**RESPONSE:** Undisputed for purposes of summary judgment only.

5. The original Constitution and Bylaws of TWHBEA, adopted in 1935, set forth rules that govern eligibility for registration in the TWHBEA Registry (TWH/NWH 4928-4937 (Art. XIV)), and the 1938 Registry included specific criteria for inclusion, including specific colors, markings on the legs, body, head, mane and tail.

**RESPONSE:** Undisputed for purposes of summary judgment only.

6. Over time, TWHBEA's selection criteria have evolved. For example, in 1974, TWHBEA researched and discussed the use of photographs of the horses' night eyes, or chestnuts for purposes of positive identification and including the photographs in the application for registration.

**RESPONSE:** Undisputed for purposes of summary judgment only.

7. TWHBEA's chart of colors and markings from 1999 includes some different color selections from the 1990 chart, and the 2006 chart includes different colors from the 1999 chart, even still.

**RESPONSE:** Undisputed for purposes of summary judgment only.

8. TWHBEA has registered its copyright in the TWHBEA Registry with the United States Copyright Office ("The Copyright Office").

**RESPONSE:** Undisputed to the extent the United States Copyright Office issued the copyright registration certificates THWBEA attached as Exhibits to the Complaint filed in this case. Otherwise, this is not a statement of fact but a conclusion of law. A plaintiff in a copyright infringement action must prove that the copyright upon which it rests its claims is valid. Don Post Studios, Inc. v. Cinema Secrets, Inc., 124 F.Supp. 2d 311, 315 (D.Pa. 2000).

9. TWHBEA's copyright notice has appeared on its Applications for Registration continuously since 1979.

**RESPONSE:** Undisputed for purposes of summary judgment only.

10. TWHBEA's copyright notice has appeared in its rule books continuously since before 1994.

**RESPONSE:** Undisputed for purposes of summary judgment only.

11. Since as early as June 1974, TWHBEA has continuously and exclusively used the service-mark TENNESSEE WALKING HORSE BREEDERS' AND EXHIBITORS' ASSOCIATION in interstate commerce, in connection with maintenance of the TWHBEA Registry, sporting events and competitions for the Tennessee Walking Horse, and informational services, printed materials and publications in the field of the Tennessee Walking Horse.

**RESPONSE:** Undisputed for purposes of summary judgment only.

12. Since as early as May 30, 1992, TWHBEA has continuously and exclusively used the service-mark TWHBEA in interstate commerce. In connection with maintenance of the TWHBEA Registry, sporting events and competitions for the Tennessee Walking Horse, and informational services, printed materials and publications in the field of the Tennessee Walking Horse.

**RESPONSE:** Undisputed for purposes of summary judgment only.

13. Since as early as May 30, 1992, TWHBEA has continuously and exclusively used the service-mark TWHBEA and Design (“the TWHBEA Design Mark”) in interstate commerce, in connection with maintenance of the TWHBEA Registry, sporting events and competitions for the Tennessee Walking Horse, and informational services, printed material and publications in the field of the Tennessee Walking Horse. A drawing of this service-mark is attached hereto as Exhibit 1.

**RESPONSE:** Undisputed for purposes of summary judgment only.

14. Since as early as July 1, 2002, TWHBEA has continuously and exclusively used the service-marks (a) TENNESSEE WALKING HORSE BREEDERS’ AND EXHIBITORS’ ASSOCIATION, (b) TWHBEA, and (c) the TWHBEA Design Mark (collectively “the TWHBEA Marks”) in interstate commerce in connection with on-line informational services, computerized communications services and on-line retail store services in the field of the Tennessee Walking Horse.

**RESPONSE:** Undisputed for purposes of summary judgment only.

15. The United States Patent and Trademark Office issued registration of the TWHBEA Design Mark, in connection with maintenance of the TWHBEA Registry, on January 31, 1995.

**RESPONSE:** Undisputed for purposes of summary judgment only.

16. When founded in 1998, NWHHA did not possess a database of pedigrees of the Tennessee Walking Horse.

**RESPONSE:** Undisputed for purposes of summary judgment only.

17. NWHHA established a registry that provides ancestral lineage information of Tennessee Walking Horses (“the NWHHA Registry”), and from which NWHHA issues certificates of pedigree and ownership registration for Tennessee Walking Horses (“the NWHHA Certificates”).

**RESPONSE:** Undisputed for purposes of summary judgment only.

18. NWHHA launched the NWHHA Registry on its website <www.nwha.com> (“the NWHHA Website”) in approximately July 2004.

**RESPONSE:** Undisputed.

19. As of July 21, 2006, NWHHA had received 164 applications from owners to register their horse(s) with NWHHA, 158 (or 96%) of which attached a TWHBEA Registry Certificate to their NWHHA application.

**RESPONSE:** Undisputed for purposes of summary judgment only.

20. Separately, as of August 22, 2006, the NWHHA online database at <www.nwha.com/search.html> (“NWHHA Website”) included 5,788 entries, 5,014 (or 87%) of which are TWHBEA-registered horses.

**RESPONSE:** Undisputed for purposes of summary judgment only.

21. From the time NWHHA first launched the Registry on the NWHHA Website in July 2004 through December 25, 2005, it encouraged the public to submit TWHBEA registration papers when applying to register with NWHHA.

**RESPONSE:** Undisputed that NWHHA stated on its website that it accepted TWHBEA registration certificates from applicants seeking to register a horse in the NWHHA registry. NWHHA never “encouraged” the public to submit THWBFA registry certificates. See Complaint, Docket No. 1, Exhibit E.

22. From July 2004 through Dumber 25, 2005, the NWHHA Website stated:

A. “NWHHA is now accepting Tennessee Walking Horse Breeders and Exhibitors Association (TWHBEA) . . . registered Walking Horses with current registration papers for registration with NWHHA.”

B. “Blood typing and parentage verification on horses that are currently registered with TWHBEA ... will be accepted.”

C. “A code will be added to every horse that is registered with [NWHHA] that will denote how each horse entered the registry. (example: TWHBEA horses will carry the letter “T”).”

D. “Be sure to send copies of both sides of TWHBEA . . . registration certificates with application to register with NWHHA.”

E. “Copies of TWHBEA or CRTWH registration papers MUST accompany registration.”

**RESPONSE:** Undisputed for purposes of summary judgment only. NWHHA would point out to the Court that THWBEA omits references to the Canadian Registry of Tennessee Walking Horses, using ellipses instead.

23. From July 2004 through December 25, 2005, the NWHHA Website included no disclaimer explaining that TWHBHA did not endorse or condone NWHHA's use of TWHBEA's trademarks.

**RESPONSE:** Undisputed.

24. NWHHA has never asked TWHBEA for permission to use the TWHBEA Marks or the TWHBEA Registry.

**RESPONSE:** Undisputed.

25. TWHBEA filed this suit against NWHHA on December 2, 2006 (sic).

**RESPONSE:** Undisputed that TWHBEA's suit was filed December 2, 2005.

26. On approximately December 26, 2005, NWHHA eventually removed all references to TWHBEA from the NWHHA Website, and added a disclaimer.

**RESPONSE:** Undisputed.

27. NWHHA continues to accept TWHBEA Registry Certificates, and has no intention to stop doing so.

**RESPONSE:** Undisputed.

28. NWHHA's application for registration contains no space to list a horse's pedigree.

**RESPONSE:** Undisputed.

29. The sole source from which NWHHA obtains a horse's pedigree is from the certificate of TWHBEA or the Canadian registry, unless that horse's pedigree is contained in the canned software that NWHHA purchased for \$100.

**RESPONSE:** Undisputed.

30. The NWHHA Registry has copied and denoted unique designations that TWHBEA has historically assigned to its horses, such as "F-38," which designates a horse was the 38<sup>th</sup> foundation horse in the TWHBEA Registry.

**RESPONSE:** Undisputed for purposes of summary judgment only.

31. After Glo's NWHHA application listed these markings: Blaze lower lip, sock left hind leg, fetlock right hind leg." But After Glo's TWHBEA Registry Certificate stated: "Near hind sock, off hind fetlock, lower lip, blaze" - which is exactly what NWHHA copied onto the NWHHA Registry Certificate that it issued for that horse.

**RESPONSE:** Undisputed for purposes of summary judgment only.

32. Son's Suede Karma's NWHHA application listed these markings: "Bald face, sock, mix flax." Its TWHBEA Registry Certificate, however, listed these markings: "Four stockings, bald, flax mane, white tail" - which is exactly what appeared on the NWHHA Registry Certificate when it was eventually issued.

**RESPONSE:** Undisputed for purposes of summary judgment only.

33. At least three individuals contacted NWHHA to ask that their horses be removed from the NWHHA Registry.

**RESPONSE:** Undisputed for purposes of summary judgment only.



34. Twelve of 16 of NWHHA's founding directors were also sitting directors of TWHBEA.

**RESPONSE:** Undisputed for purposes of summary judgment only.

35. Approximately all NWHHA board members are current or former members of TWHBEA.

**RESPONSE:** Undisputed for purposes of summary judgment only.

36. NWHHA only requires DNA testing for those horses applying for NWHHA-registration that have never been registered with TWHBEA or the Canadian registry.

**RESPONSE:** Undisputed for purposes of summary judgment only.

37. Many NWHHA members continued to register their horses with TWHBEA even after NWHHA launched its own registry.

**RESPONSE:** Undisputed for purposes of summary judgment only.

38. TWHBEA first learned of NWHHA's infringing conduct in the spring of 2005.

**RESPONSE:** Undisputed for purposes of summary judgment only.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that a true and exact copy of the foregoing has been served via ECF, on this 5<sup>th</sup> day of December 2006, on the following:

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